

REMARKS

This Amendment is submitted in reply to the Final Office Action dated February 15, 2012. Applicant respectfully requests reconsideration and further examination of the patent application pursuant to 37 C.F.R. § 1.113.

Summary of the Examiner's objections and rejections

Claims 1, 5, 8 and 9 are objected to because of an alleged informality where the limitation "each extra port is set-up independent if monitoring is requested or not" is not grammatically correct. Applicant is advised to amend this to read "each extra port is set-up independent [of] if monitoring is requested or not".

The specification stands objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter "each extra port is unique to a particular new session".

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Albers (US 6,097,798) in view of Benitez Pelaez, et al. (US 2004/0190689) in further view of Mazzola (US 5,796,732)

Summary of claim amendments

Applicant has amended claims 1, 5, 8, and 9, and added new claims 10-13. The support for the amendments to the claims 1, 5, 8, and 9 can be on page 8, lines 2-4 in the originally filed patent application. The support for the new claims 10-13 can be found on page 7, lines 11-28 and FIG. 3 of the originally filed patent application. No new subject matter has been added.

Remarks regarding claim objections

Claims 1, 5, 8 and 9 are objected to because of an alleged informality where the limitation "each extra port is set-up independent if monitoring is requested or not" is not grammatically correct. Applicant is advised to amend this to read "each extra port is set-up independent [of] if monitoring is requested or not". Applicant traverses this objection. However, in the interest of advancing the prosecution of this patent application the Applicant has amended claims 1, 5, 8, and 9 to correct informalities per

the Examiner's request. Accordingly, Applicant respectfully requests the removal of the pending claim objections.

Remarks regarding specification objections

The specification stands objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter "each extra port is unique to a particular new session". Applicant traverses this objection. The support for the claimed subject matter "each extra port is unique to a particular new session" can be found on page 7, lines 11-28 of the originally filed patent application. The cited portions are quoted below:

Figure 3 discloses the media-handling node MHN shown in figure 2. The media-handling node can for example be a PSTN gateway used in public switching networks, a video gateway for video applications or a conference bridge used in multiple party conferences. The MHN in figure 3 comprises so-called first ports P1-P15 and second ports PO1-PO5. A media session flow between two subscribers is transported bi-directional in the media-handling node MHN between a first and second port. In the example in figure 3, five media session flows are transported in the MHN. According to the invention every session that is set up in the node MHN is assigned an extra port XP1-XP5 in the MHN. A media session between P11 and PO1 for example is the cause of an extra port XP1. Media multiparty sessions between more than two ports in the MHN are treated in a similar way. If a session is set up between one first port P11 and a number of second ports, PO1-PO_n, an extra port PX1 is always assigned to this session.

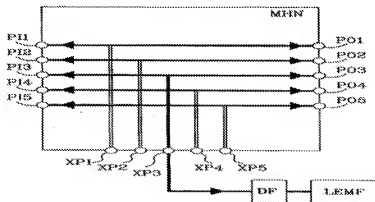


Fig. 3

(see page 7, lines 11-28 and FIG. 3)

As can be seen, there is clearly support for the claimed subject matter "each extra port is unique to a particular new session" with at least the specification's teachings of "[t]he MHN in figure 3 comprises so-called first ports P11-P15 and second ports PO1-PO5. A media session flow between two subscribers is transported bi-directional in the media-handling node MHN between a first and second port. In the example in figure 3, five media session flows are transported in the MHN. According to the invention every session that is set up in the node MHN is assigned an extra port XP1-XP5 in the MHN. A media session between P11 and PO1 for example is the cause of an extra port XP1". Furthermore, FIG. 3 clearly shows that the extra port XP1 is "unique" to the particular session associated with ports P11 and P01 because the extra port XP1 is not associated with the other sessions between ports P12-PO2, P13-PO3, P14-PO4, and P15-PO5. The same is true for the other extra ports XP2, XP3, XP4, and XP5. Accordingly, Applicant respectfully requests the removal of the pending claim objections.

Remarks regarding the §103(a) rejections

Applicant respectfully submits that the amended independent claim 1 is patentable over Albers, Benitez Pelaez, Mazzola or any combination thereof. The amended independent claim 1 recites the following:

1. Method for monitoring media session flow in a telecommunication network comprising a media-handling node through which, sessions between subscribers are transported via first ports and second ports comprising the following steps:

assigning an extra port to the media-handling node of an internet protocol multimedia subsystem domain for each new session that is transported through the node, each extra port is unique to a particular new session, and each extra port is set-up independent of if monitoring is requested or not;

storing in a database, identification of a first subscriber for which monitoring is desired;

setting up a connection between the first subscriber and a second subscriber;

assigning an extra port that is adherent to the session between the first and second subscriber;

connecting the assigned extra port that is adherent to the session between the first and second subscriber;
monitoring the session between the first and second subscriber via the connected extra port (emphasis added).

The proposed Albers-Benitez Pelaez-Mazzola combination fails to disclose, teach, or suggest every element of the amended claim 1. For example, the proposed Albers-Benitez Pelaez-Mazzola combination fails to disclose at least the claimed feature "each extra port is unique to a particular new session". The Examiner acknowledged that the Albers-Benitez Pelaez combination does not expressly disclose "each extra port is unique to a particular new session" (see Office Action at page 7, lines 17-19). In an attempt to overcome this deficiency in the Albers-Benitez Pelaez combination, the Examiner proposed combining Albers-Benitez Pelaez with Mazzola. However, Mazzola also fails to disclose the claimed feature "each extra port is unique to a particular new session". In contending that Mazzola discloses the claimed feature "each extra port is unique to a particular new session", the Examiner stated the following:

Albers and Benitez Pelaez do not expressly disclose each extra port is unique to a particular new session, and each extra port is set-up independent [of] if monitoring is requested or not.

Mazzola discloses each extra port is unique to a particular new session, and each extra port is set-up independent [of] if monitoring is requested or not. (col. 5, line 49 - col. 6, line 51, disclosing that for each frame, a "unique destination index value 380" is used in forwarding the frame to particular port(s) of a switch, and that such "index 380" is determined based on "the frame's destination address", thus teaching that for frames of the same destination [i.e., frames of a "particular session"], the same "index 380" is determined and associated with such frames; further teaching that "the destination of any frame may be one or more ports located on one or more cards of the switch" and that for a multicast/broadcast frame, the associated "index 380" derived from its destination address maps to a "group of ports", i.e., more than one port of the switch, thus teaching an "extra port"; and since each frame with the same destination address [i.e., in the same "session"] is associated with the same "group of ports" due to the shared destination address, thus further teaching "each extra port is unique to a particular new session".....

(see Office Action at page 7, line 20 - page 8, line 11).

Applicant appreciates the Examiner's effort in explaining why he/she believes Mazzola discloses the claimed feature "each extra port is unique to a particular new session". However, Applicant has reviewed the cited portions of Mazzola and contends the Examiner's conclusion is misplaced and that Mazzola fails to disclose the claimed feature "each extra port is unique to a particular new session". In this regard, Mazzola discloses that a frame's destination address maps to a unique destination index value 380 (i.e., unique index of one or more ports) which maps to a predetermined port select signal that selects one or more ports on one or more cards as a destination of the frame (see col. 5, line 49-col. 6, line 39). As such, Mazzola does not disclose where a port itself is limited (i.e., unique) to one session between network entities. In this regard, the Examiner should appreciate the Mazzola's network switch can utilize one or more ports to forward frames associated with one session from one sending network entity to one or more receiving network entities. Plus, the Examiner should appreciate that Mazzola's network switch can utilize the same one or more ports to forward frames associated with another session from another sending network entity to the same receiving network entities. Stated another way, Mazzola's network switch can utilize the same port to send frames to a particular receiving network entity even when the frames are part of multiple sessions and are sent by multiple sending network entities. Hence, Mazzola does not disclose where the port or ports are unique (i.e., limited) to a particular session but instead discloses where the port is based on the destination address of the receiving network entity and the same receiving network entity can have multiple sessions using the same port with multiple sending network entities. In view of at least the foregoing, the Applicant respectfully submits that the amended independent claim 1 is patentable over Albers, Benitez Pelaez, Mazzola or any combination thereof and that the corresponding dependent claims 2-4 and 10 are also patentable, at least by the virtue of their dependence to the amended independent claim 1.

Furthermore, even if one were to assume that the proposed Albers-Benitez Pelaez-Mazzola combination discloses each and every element of the amended claim 1 (which it does not) there is still no rationale to support a conclusion that the amended claim 1 is *prima facie* obvious. The Examiner is reminded where it is well known that "if the proposed medication or combination of the prior art would change the principle of

operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious". *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)(MPEP 2143.01 VI). In the present case, if one were to modify Alber's system in an attempt to read on the claimed invention then the proposed change to Alber's system would change its principle of operation and when this occurs then the teachings of Albers-Benitez Pelaez-Mazzola are not sufficient to render the amended claim 1 *prima facie* obvious. In this regard, Albers discloses where the SCP 120 determines if a call is to receive surveillance monitoring and then the 5ess switch's CALEA module confirms if the call to a target is to receive surveillance monitoring and then the CALEA module performs two primary functions: it routes the call to the target telephone and it implements surveillance against the target (see col. 7, line 64-col. 8, line 47). Thus, Alber's 5ess switch does not set-up a port for surveillance monitoring of a particular call until after determining that the particular call is to receive surveillance monitoring while the amended independent claim 1 recites "each extra port is set-up independent of if monitoring is requested or not" and then in subsequent claimed steps where if monitoring is required then the extra port that is set-up and assigned to the session between the first and second subscriber is actually connected so the session between the first and second subscriber can be monitored via the connected extra port. As can be seen, the Examiner's suggested combination of Albers-Benitez Pelaez-Mazzola would also require a substantial reconstruction and redesign of the elements shown in the primary reference Albers as well as a change in the basic principle under which Albers's system was designed to operate. In view of at least the foregoing, the Applicant respectfully submits that the amended independent claim 1 is patentable over Albers, Benitez Pelaez, Mazzola and that the corresponding dependent claims 2-4 and 10 are also patentable, at least by the virtue of their dependence to the amended independent claim 1.

Alternatively, even if one were to assume that the proposed Albers-Benitez Pelaez-Mazzola combination discloses each and every element of the amended claim 1 (which it does not) there is still no rationale to support a conclusion that the amended claim 1 is *prima facie* obvious. As described above, the Examiner acknowledged that the Albers-Benitez Pelaez combination does not expressly disclose "each extra port is

unique to a particular new session" (see Office Action at page 7, lines 17-19). In an attempt to overcome this deficiency in the Albers-Benitez Pelaez combination, the Examiner proposed combining Albers-Benitez Pelaez with Mazzola and citing the motivation for such a combination stated the following:

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to utilize the teachings disclosed in Mazzola, in conjunction with the method as disclosed and taught by Albers and Benitez Pelaez. Therefore, Albers, Mazzola and Benitez Pelaez are combinable to teach and disclose "means for assigning an extra port to the media handling node of an internet protocol multimedia subsystem domain for each new session that is transported through the node, each extra port is unique to a particular new session, and each extra port is set-up independent [of] if monitoring is requested or not". The suggestion or motivation would have been to provide a more efficient, robust and enriched method of data and network communications. (Albers, col. 3, lines 13-35; Benitez Pelaez, paragraphs 1, 6 and 7; Mazzola, cols. 1 and 2).

(see Office Action at page 9, lines 1-11)(emphasis added)

However, Applicants respectfully submit that this is not a proper suggestion for combining Albers-Benitez Pelaez with Mazzola. Applicants wish to remind the Examiner of the basic legal principles for rejecting a claim under 35 U.S.C. §103. Specifically, in *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained:

To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

Id. at 1455 (citations omitted and emphasis added).

In the Rouffet case, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the

references in the manner proposed by the Examiner. As explained by the Federal Circuit:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

Id. at 1457-58 (citations omitted and emphasis added).

These principles have not been followed in rejecting the amended independent claim 1. Because, by merely stating that there is a motivation to combine the references in order to “provide a more efficient, robust and enriched method of data and network communications” as was done to reject the amended independent claim 1 is not the same as “show[ing] a motivation to combine the references.” In particular, the problem with the Examiner’s logic is that it effectively eliminates the requirement of identifying a factual suggestion for combining references from the obviousness analysis. And, since it is a statutory requirement that all inventions have utility, there will also always be an identifiable end or advantage in combining the elements in the prior art in the manner proposed by any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claimed apparatus, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the “suggestion” requirement of 35 U.S.C. § 103 can be met by merely stating there is desire to “provide a more efficient, robust and enriched method of data and network communications” then the suggestion requirement can always be met and is utterly meaningless. Simply put, there is *always* an advantage associated with improving a method or device that can be met by combining old elements which can be identified through hindsight *once that combination is known*. Accordingly, the Applicant respectfully submits that the §103 rejection of the amended independent claim 1 be

withdrawn because the Examiner failed to identify a legally proper suggestion for combining Albers-Benitez Pelaez with Mazzola. In other words, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. In view of at least the foregoing, the Applicant respectfully submits that the amended independent claim 1 is patentable over Albers, Benitez Pelaez, Mazzola and that the corresponding dependent claims 2-4 and 10 are also patentable, at least by the virtue of their dependence to the amended independent claim 1.

Applicant respectfully submits that the amended independent claims 5, 8, and 9 are patentable in view of Albers, Benitez Pelaez, Mazzola. The amended independent claims 5, 8 and 9 recite the same or similar distinguishing limitations that have been discussed above with respect to the amended independent claim 1. As such, the aforementioned remarks regarding the patentability of the amended independent claim 1 apply as well to the amended independent claims 5, 8 and 9. Accordingly, Applicant respectfully requests the allowance of the amended independent claims 5, 8, and 9 and their corresponding dependent claims 6-7 and 11-13.

Remarks regarding the new dependent claims 10-13

Applicant respectfully submits that the new dependent claim 10 is patentable in view of Albers, Benitez Pelaez, Mazzola or any combination thereof. The new dependent claim 10 is as follows:

10. The method according to claim 1, where each extra port is unique to the particular new session comprises where one of the extra ports is set-up and assigned to only one of the new sessions and not set-up and assigned to any of the other new sessions.

The new dependent claim 10 further clarifies how "each extra port is unique to the particular new session" by reciting "where one of the extra ports is set-up and assigned to only one of the new sessions and not set-up and assigned to any of the other new sessions". Accordingly, Applicant respectfully requests the allowance of the new dependent claim 10.

Applicant respectfully submits that the new dependent claims 11-13 are patentable in view of Albers, Benitez Pelaez, Mazzola. The new dependent claims 11-13 recite the same or similar distinguishing limitations that have been discussed above with respect to the new dependent claim 10. As such, the aforementioned remarks regarding the patentability of the new dependent claim 10 apply as well to the new dependent claims 11-13. Accordingly, Applicant respectfully requests the allowance of the new dependent claims 11-13.

CONCLUSION

In view of the foregoing remarks, Applicant believes all of the claims currently pending in the application to be in a condition for allowance. Therefore, Applicant respectfully requests that the Examiner withdraw all objections and rejections and issue a Notice of Allowance for pending claims 1-13.

The Commissioner is hereby authorized to charge any fees for this paper to Deposit Account No. 50-1379.

Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

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